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Filing date: **03/29/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|--|
| Proceeding | 91186986 |
| Party | Plaintiff LOEST & McNAMEE, INC. |
| Correspondence Address | Paulette R. Carey Buchman Law Firm, LLP 510 Thornall Street Suite 200 EDISON, NJ 08837 UNITED STATES prcarey@buchmanlaw.com |
| Submission | Other Motions/Papers |
| Filer's Name | Paulette R. Carey |
| Filer's e-mail | prcarey@buchmanlaw.com |
| Signature | /Paulette R. Carey/ |
| Date | 03/29/2010 |
| Attachments | 3-29-2010 Loest & McNamee Opposition - Suspension of Motion.pdf (3 pages) (190658 bytes) 11.18.09 Opposers First Request for Admissions.pdf (3 pages)(98311 bytes) 3.04.2010 S. Roberts Allen - Answer to Opposer's request for Admissions.pdf (7 pages)(447667 bytes) |

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77-247611
Published in the Official Gazette of January 26, 2010

| | | |
|-----------------------|---|----------------|
| |) | Opposition No. |
| |) | 91186986 |
| LOEST & McNAMEE, INC. |) | |
| |) | |
| |) | |
| Opposer, |) | |
| |) | |
| |) | |
| vs. |) | |
| |) | |
| Shaun Roberts Allen |) | |
| |) | |
| Applicant, |) | |
| |) | |
| |) | |

Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313, 1451

**OPPOSER'S MOTION
FOR SUSPENSION OF THE PROCEEDING**

Opposer hereby moves that the proceeding be suspended pending disposition of a revocation action in New Zealand against the registration on which the opposed application is based.

BACKGROUND

1. Application no. 77247611 was filed on the basis of Section 44 (e) claiming New Zealand Registration no. 707364.
2. Opposer served discovery requests, including a First Request For Admissions, on applicant dated November 18, 2009. A copy of the Admission Requests together with the Certificate of Service are annexed hereto as Exhibit A.
3. In its Responses (copy annexed hereto as Exhibit B), Applicant admitted that New Zealand Registration no. 707364 is the subject of a revocation proceeding (Response to Request no. 14).

ARGUMENT

I. OPPOSER MOVES THAT THIS PROCEEDING BE SUSPENDED PENDING THE DISPOSITION OF NEW ZEALAND REGISTRATION NO. 707364.

Application no. 77247611 was filed on the basis of Section 44(e) claiming New Zealand Registration no. 707364. TMEP§1004(1) specifies that a 44(e) application requires a *valid* registration in applicant's country of origin. Further, TMEP§1004.01(a) requires that the underlying foreign registration be in effect at the time the United States registration issues. The underlying New Zealand Registration is the subject of a revocation action in the Intellectual Property office of New Zealand (admission no. 14). In the event that the New Zealand Registration no. 707364 is revoked, the filing basis of the pending Application no. 77247611 will be invalid. Moreover, the requirement of TMEP§1004.01(a) cannot be satisfied and the application must be refused on that basis. In such event, and the subject proceeding will be moot.

Accordingly, Opposer requests that the current opposition proceeding be suspended pending disposition of the proceeding in the New Zealand Intellectual Property office against New Zealand Registration no. 707364.

CONCLUSION

For the foregoing reasons Opposer requests that the current proceeding be suspended pending disposition of the revocation proceeding in the New Zealand Intellectual Property office against New Zealand Registration no. 707364.

Dated: March 29, 2010

Respectfully Submitted,

BUCHMAN LAW FIRM, LLP
Attorneys for Opposer

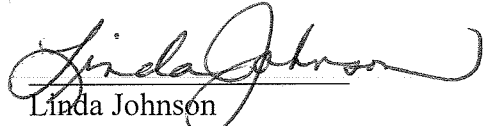
By: 

Paulette R. Carey
510 Thornall Street, Suite 200
Edison, NJ 08837
(732) 632-6060

Certificate of Service

I hereby certify that on March 29, 2010, I served the foregoing OPPOSER'S MOTION FOR SUMMARY JUDGMENT by delivering a copy to the United States Postal Service, as first class mail postage prepaid in an envelope addressed to:

James. B. Astrachan
Astrachan Gunst & Thomas, P.C.
217 East Redwood Street, 21st Floor
Baltimore, MD 21202


Linda Johnson

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77247611
Published in the Official Gazette of March 4, 2008

| | | |
|-----------------------|---|------------------------|
| LOEST & McNAMEE, INC. |) | <u>OPPOSER'S FIRST</u> |
| |) | <u>REQUEST FOR</u> |
| |) | <u>ADMISSIONS</u> |
| |) | |
| Opposer, |) | |
| |) | |
| |) | |
| vs. |) | |
| |) | |
| Shaun Roberts Allen |) | |
| |) | |
| Applicant, |) | |
| |) | |
| |) | |
| |) | |

Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, Loest and McNamee, through its undersigned attorneys, hereby requests that applicant, Shaun Roberts Allen, admit under oath or declaration pursuant to Rule 35 of the Federal Rules of Civil Procedure and C.F.R. §2.120, the truth of the following facts:

1. Applicant filed application serial no. 77247611 to register the mark SILVER FERN for use on wines, spirits, liqueurs and alcoholic beverages other than beer.
2. The word SILVER is often used on consumer goods such as alcoholic beverages to indicate quality.
3. The term SILVER is laudatory.
4. The word FERN is the dominant portion of applicant's mark.
5. The word FERN in the applied for mark is identical to Opposer's mark in registration no. 2906981.

6. The goods wines listed in application no. 77247611 are identical to the goods in registration no. 2906981.

7. The goods sold under the applied for mark are sold through the same retail outlets as goods sold under Opposer's mark.

8. Consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33.

9. Consumers familiar with registrant's mark FERN are likely to believe that the mark SILVER FERN is a line extension of Opposer's brand and that Opposer is the source or origin of applicant's goods.

10. Registration no. 2406981 issued on November 30, 2004.

11. Registration no. 2906981 is valid and subsisting.

12. Opposer's priority in its mark predates any priority which may be claimed by applicant in the mark SILVER FERN and in application no. 77247611.

13. Registration no. 2906981 is *prima facie* evidence of Opposer's exclusive right to use the mark of Opposer's exclusive right to use the mark FERN on goods in international class 33.

14. New Zealand registration no. 707364 is the subject of a revocation action in the Intellectual Property Office of New Zealand.

Dated: November 18, 2009

Respectfully Submitted,

BUCHMAN LAW FIRM, LLP
Attorneys for Opposer

By: 

Paulette R. Carey

510 Thornall Street, Suite 200

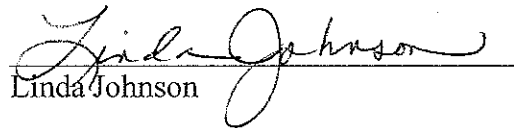
Edison, NJ 08837

(732) 632-6060

CERTIFICATE OF SERVICE

I hereby certify that on November 18, 2009, I served the foregoing Opposer's First Request for Admissions by delivering a copy to the United States Postal Service, as first class mail postage prepaid in an envelope addressed to:

James B. Astrachan
Astrachan Gunst & Thomas, P.C.
217 East Redwood Street, 21st Floor
Baltimore, MD 21202


Linda Johnson

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77247611
Published in the Official Gazette of March 4, 2008

LOEST & McNAMEE, INC.

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Opposer

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v.

*

ANSWER TO OPPOSER'S
REQUEST FOR ADMISSIONS

Shaun Roberts Allen

*

Applicant

*

* * * * *

**APPLICANT SHAUN ROBERTS ALLEN'S RESPONSES TO OPPOSER
LOEST & McNAMEE, INC.'S REQUEST FOR ADMISSION OF FACTS**

GENERAL OBJECTIONS AND RESERVATION OF RIGHTS

The following General Objections respond to all Requests for Admissions, regardless of whether specifically repeated in the individual Responses and Objections:

A. Mr. Allen generally objects to Loest & McNamee's *Requests* to the extent they purport to impose obligations and duties upon Mr. Allen beyond those set forth in the Federal Rules.

B. Mr. Allen generally objects to Loest & McNamee's *Requests* to the extent they purport to impose upon Mr. Allen a duty to admit or deny facts or allegations unknown to Mr. Allen or about which Mr. Allen has insufficient information and/or knowledge with which to form a belief as to their truth or falsity, and which information or knowledge is not likely to become known or available through reasonable investigation.

C. Mr. Allen reserves the right to supplement its Responses as additional information becomes available.

D. Mr. Allen reserves all rights and privileges to make and defend against any argument in law or equity, and these admissions and denials shall not impair or erode, or otherwise act to waive, such rights and privileges.

INDIVIDUAL RESPONSES AND OBJECTIONS

REQUEST NO. 1: Applicant filed application serial no. 77247611 to register the mark SILVER FERN for use on wines, spirits, liqueurs and alcoholic beverages other than beer.

RESPONSE: Admit.

REQUEST NO. 2: The word SILVER is often used on consumer goods such as alcoholic beverages to indicate quality.

OBJECTION: Plaintiff objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Regardless of whether the word SILVER is often used on consumer goods to indicate quality, the word SILVER in the relevant mark is not used to indicate quality of the alcoholic beverages. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 3: The term SILVER is laudatory.

OBJECTION/RESPONSE: Plaintiff objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Plaintiff further objects to this request to the extent that the term “laudatory” implies that Mr. Allen’s mark uses SILVER in a laudatory fashion, as Mr. Allen denies and does not admit that the term SILVER is used in this way and believes it is used arbitrarily. Plaintiff further objects on the basis that the term SILVER is undefined, vague and therefore confuses the issue of its use in the mark. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 4: The word FERN is the dominant portion of applicant’s mark.

RESPONSE: Deny. The word FERN is not the dominant portion of Mr. Allen's mark. The words SILVER and FERN in the mark are given equal weight and are to be used in conjunction with each other, not separated into individual terms. A silver fern is a species of tree fern endemic to New Zealand that has become one of the most widely recognized symbols of the country. It is often used as a logo for many organizations in New Zealand and permeates all aspects of the culture, from politics to sports. The terms in the mark should be read together as SILVER FERN to connote the symbol of New Zealand, and thus neither term in the mark dominates the other.

REQUEST NO. 5: The word FERN in the applied for mark is identical to Opposer's mark in registration no. 2906981.

RESPONSE: Admit, as to only the word FERN. The connotations of the marks are not identical – nor is the commercial impression, sound or meaning that is created when the words SILVER and FERN are joined as a mark comprised of the words. Thus, although Mr. Allen admits the matter of fact asserted in Request No. 5, material facts not included or referred to in Request No. 5 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 6: The goods wines listed in application no. 77247611 are identical to the goods in registration no. 2906981.

RESPONSE: Admit, except to state that the *category of goods* are identical, not the individual wines. Thus, although Mr. Allen admits the matter of fact asserted in Request No. 6, material facts not included or referred to in Request No. 6 result in a materially misleading

statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 7: The goods sold under the applied for mark are sold through the same retail outlets as goods sold under Opposer's mark.

RESPONSE: Generally, this may be true, but it remains to be seen whether the goods will be sold through the same distributors in various states to the same retail outlets.

REQUEST NO. 8: Consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33.

RESPONSE: Mr. Allen objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Further, there is no quantifiable evidence presented that indicates that consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33. Mr. Allen denies any portion of this Request not expressly address and admitted herein.

REQUEST NO. 9: Consumers familiar with registrant's mark FERN are likely to believe that the mark SILVER FERN is a line extension of Opposer's brand and that Opposer is the source or origin of applicant's goods.

RESPONSE: Deny.

REQUEST NO. 10: Registration no. 2906981 issued on November 30, 2004.

RESPONSE: Admit.

REQUEST NO. 11: Registration no. 2906981 is valid and subsisting.

RESPONSE: Admit.

REQUEST NO. 12: Opposer's priority in its mark predates any priority which may be claimed by applicant in the mark SILVER FERN and in application no. 77247611.

RESPONSE: Admit that Opposer used FERN first, in the United States; the mark sought to be registered by Mr. Allen is SILVER FERN and this mark was used in New Zealand, Europe and Australia before Opposer's registration of FERN in the United States. Material facts not included or referred to in Request No. 12 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 13: Registration no. 2906981 is *prima facie* evidence of Opposer's exclusive right to use the mark FERN on goods in international class 33.

RESPONSE: Admit, but that presumption is clearly rebuttable.

REQUEST NO. 14: New Zealand registration no. 707364 is the subject of a revocation action in the Intellectual Property Office of New Zealand.

RESPONSE: Admit, except to state that the registration no. 707364 is the subject of a revocation action for non-use in New Zealand. Mr. Allen nevertheless asserts that the mark is in use and is valid and subsisting in New Zealand, and he has filed a counterstatement and evidence in support of use. Material facts not included or referred to in Request No. 14 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

Date: March 10, 2010

Respectfully submitted,

/James B. Astrachan/

James B. Astrachan
Astrachan Gunst Thomas, P.C.

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410.783.3550 telephone
410.783.3530 facsimile

Attorneys for Applicant
Shaun Roberts Allen

CERTIFICATE OF SERVICE

I hereby further certify that, on this 10th day of March, 2010, a copy of the Answer to Opposer's Request for Admissions and this Certificate of Service were served upon Opposer's counsel, by first-class, United States mail, postage pre-paid and electronic delivery upon:

Paulette R. Carey
Buchman Law Firm, LLP
510 Thornall Street Suite 200
EDISON, NJ 08837
prcarey@buchmanlaw.com

Date: March 10, 2010

Respectfully submitted,

/James B. Astrachan/

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Attorneys for Applicant
Shaun Roberts Allen